GAU 1631
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PATENT
Customer Number 22,852
Attorney Docket No. 07691.0009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kurt HERTOGS et al.

Application No.: 09/580,491

Filed: May 30, 2000

For: NEW MUTATIONAL PROFILES IN HIV-1 PROTEASE AND REVERSE TRANSCRIPTASE CORRELATED WITH PHENOTYPIC DRUG RESISTANCE

Group Art Unit: 1631

Examiner: S. Siu

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated February 27, 2001, Applicants respectfully request reconsideration of the subject application in light of the following remarks.

Claims 1-30 are pending in this application. In the Office Action, the Office required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I, Claims 1-6 drawn to a computer system, classified in class 702, subclass 20;

Group II, Claims 7-11 drawn to a method of evaluating the effectiveness of anti-HIV therapy, classified in class 435, subclass 5;

Group III, Claims 12-15 drawn to a method of screening for drugs against NNRTI resistant strains of HIV, classified in class 435, subclass 5;

Group IV, Claims 16-21 drawn to a method of screening for drugs against NRTI resistant strains of HIV, classified in class 435, subclass 5;

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

Group V, Claims 22-24 drawn to a method of screening for drugs against PI resistant strains of HIV, classified in class 435, subclass 5;

Group VI, Claims 25-29 drawn to a method of designing anti-HIV therapy, classified in class 530, subclass 412; and

Group VII, Claim 30 drawn to a method of determining drug sensitivity of an HIV population in a sample, classified in class 436, subclass 500.

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants provisionally elect to prosecute Group II, Claims 7-11 drawn to a method of evaluating the effectiveness of anti-HIV therapy.

The Applicants refer the Office to M.P.E.P. § 803, which sets forth the criteria and guidelines for the Office to follow in making proper requirements for restriction. The M.P.E.P. instructs the Office as follows:

> If the search and examination of an entire application can be made without **serious burden**, the Office **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

The Office has not shown that examining Groups I - VII would constitute a serious burden. For example, as the Office states, Groups II, III, IV, and V are classified as part of the same class, *i.e.*, 435, and Groups III, IV, and V are classified as part of the same class and the same subclass, *i.e.*, class 435, subclass 5. It is not understood how the Office can possibly argue that searching the same class and subclass constitutes a serious burden.

At the very least, the Office should examine Groups II, III, IV, and V in response to the Applicants election, with traverse, of the subject matter of Group II, claims 7-11.

LAW OFFICES
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FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
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Again, the critical issue is not whether these groups are unrelated but whether there is a serious burden to the Office in examining the Groups together. In view of the foregoing remarks, Applicants respectfully submit that simultaneous examination of Groups II, III, IV, and V cannot reasonably be argued to constitute a serious burden and request that the requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: April 27, 2001

By: _____
Anthony C. Tridico
Reg. No. 45,958

LAW OFFICES
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000